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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/832,622	04/11/2001	John J. Potenza	SE001U	1826
23419	7590	11/03/2005		
COOLEY GODWARD, LLP 3000 EL CAMINO REAL 5 PALO ALTO SQUARE PALO ALTO, CA 94306			EXAMINER NGUYEN, TAN D	
			ART UNIT	PAPER NUMBER
			3629	

DATE MAILED: 11/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/832,622

Applicant(s)

POTENZA, JOHN J.

Examiner

Tan Dean D. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,5-18 and 20-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,5-18 and 20-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

The amendment filed 6/15/05 has been received and entered.

Claim Status

Claims 1-3, 5-18, 20-47 are active and are rejected as followed.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. Claims 39-43 (method¹), 1-3, 5, 7, 9, 12-16 (method²), 17-18, 21, 26-30 (method³), 31-38 (method⁴), 44-47 (method⁵), are rejected under 35 U.S.C. 103(a) as being unpatentable over www.Bizrate.com (* Feb 29, 2000) in view of REBANE (US Patent 6,539,392) or vice versa.

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As for independent method¹ claim 39, www.Bizrate.com discloses a method for providing business strategy recommendations to a service provider (merchant) comprising:

(a.) receiving, at an automated evaluation processor, transaction information representative of transactions involving the service provider (merchant) and a service evaluator (consumer);

(b.) receiving, at the evaluation processor, evaluation data indicative of an evaluation of one or more of transactions by at least one of the one or more service evaluator (consumer):

(c.) processing the information and data using statistical analysis to produce a follow-up file to the provider (merchant) or customer,

(d.) providing, in accordance with parameters provided by the at least one service provider, at least one business strategy recommendation to the service provider based upon the follow-up file {see Solutions / Consulting Services, note (b) 3, or (c), 1, 2, 3, 4,}. Www.Bizrate.com fairly teaches the claimed except for carrying out step (c) using correlating.

In a similar process for data collection (survey questionnaire), evaluation, generation of ideas on e-commerce, REBANE, whose assignee is www.Bizrate.com, appears to further discuss about the same service as in www.Bizrate.com, discloses:

(a.) receiving, at an automated evaluation processor, transaction information representative of transactions involving the service provider (merchant) and a service evaluator (consumer) {col. 8, lines 32-39};

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(b.) receiving, at the evaluation processor, evaluation data indicative of an evaluation of one or more of transactions by at least one of the one or more service evaluator (consumer) {col. 8, lines 32-39, Figs. 1a-1g, 2a-2b}:

(c.) processing /analyzing the received information and data using statistical analysis to produce an evaluation file (trends, relevant business related information) to the provider (merchant) or customer,

(d.) providing, in accordance with parameters provided by the at least one service provider, results of the processed data (survey) from the evaluation file above to quickly alert the service provider so that the provider can take appropriate action to protect and advance their business's well being or to predict growth rates and limits of variables relating to the business {see col. 4, lines 20-30, c25:20-30}. REBANE fairly teaches claimed invention except for explicitly providing business strategy recommendation to the service provider.

It would have been obvious to modify the teaching of www.Bizrate.com by implementing correlating in step (c.) as taught by REBANE to properly and accurately process and evaluate the data and providing valuable follow-up data for further survey evaluation/reporting. Note that the phrase "strategy capable of being implemented by" carries no patentable weight in a method claim since this merely refers to "capability" or "potential" of the recommendation and no further step has been carried out. The recommendation of www.Bizrate.com /REBANE inherently includes that capability or strategy (see page "Consulting Services", note (C), items 1-4).

Alternatively, it would have been obvious to modify the teachings of REBANE by implementing the step of providing business strategy recommendation (consulting service or providing solutions) to the service provider as taught by www.Bizrate.com to inherently receive fee or payment (money) for service which is well known practice.

As for dep. claims 40-43 (part of 39 above), which deals with communication between the provider / merchant and the evaluator (or Consulting Services} with respect to business strategies and implantation, etc., these are taught on page "Consulting Services", note (C), items 1-4.

As for independent method² claim 1, which has similar limitations as in independent method claim 39 above, it's rejected for the same reason set forth in claim 39 above.

As for dep. claims 2, 7 (part of 1), which has similar limitation as in dep. claim 2 above, it's rejected for the same reason set forth in dep. claims 40-41 above. Furthermore, claim 2 merely further limits the "recommendation", i.e. how the strategy recommendation is selected?, and this does not further limit the step (d) of "providing" above and thus carry no patentable weight.

As for dep. claims 3, 5 (part of 1), which deal with well known survey parameters, providing a unique service evaluator identifier for record keeping or tracking purpose, this is inherently included in www.Bizrate.com /REBANE or would have been obvious to implement this step for effective record keeping or tracking purpose.

As for dep. claim 9 (part of 1), which further limits the object file in step (c.), i.e. file is automatically transmitted to the provider, this carry little or no patentable weight in

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a method step "correlating". Moreover, this is taught in www.Bizrate.com /REBANE above.

As for dep. claim 12 (part of 1), which deal with well known survey parameters, providing a unique service evaluator transaction record and incentive for responding to the survey, this is inherently included in www.Bizrate.com /REBANE under "Merchant – Demo", "Evaluation of:" "a chance to win up to \$5,000" or would have been obvious to implement this step for effective record keeping or tracking purpose.

As for dep. claims 13-16 (part of 1), which deal with well known survey parameters, using of automatic inquiry/response system including telephone or Internet, these are inherently included in www.Bizrate.com /REBANE. The use of other equivalent digital communication system, telephone, etc., would have been obvious as mere using other similar communication means to achieve similar results.

As for independent claims 17 (method³), 31 (method⁴), which has similar limitations as in method claim 1, they are rejected for the same reason set forth in claim 1 above.

As for dep. claims 18 (of 17), and 32 (of 31), which have the same limitations as in dep. claim 2 above, they are rejected for the same reasons set forth in dep. claim 2 above.

As for dep. claim 21 (of 17), which have the same limitations as in dep. claim 7 above, it's rejected for the same reasons set forth in dep. claim 7 above.

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As for dep. claims 26-30 (of 17), and 34-38 (of 31), which have the same limitations as in dep. claims 12-16 (part of 1), they are rejected for the same reasons set forth in dep. claims 12-16 above.

As for dep. claim 33 (of 31), which have the same limitations as in dep. claim 3 above, they are rejected for the same reasons set forth in dep. claim 3 above.

As for independent claims 44, 46(method⁵) which has similar limitations as in method claim 39 but has another step of matching and associating the evaluation data from the evaluator (customer) to the transaction information/record for proper evaluation of the right person & record, this is fairly taught in REBANE col. 12, lines 32-67, wherein the data that enters data capture relate to an online commercial transaction such as the type discussed above relative to survey question 100 and 200. Note that on lines 64-67, REBANE discloses the presentation of the survey to the customer contemporaneously (same time) with a transaction or some defined time after transaction or both. Clearly, the intention is making sure the survey matches with the transaction data/record so an accurate evaluation can be carried out. Therefore, the step of matching the evaluation data with the transaction data is inherently included from the teachings above or would have been obvious to do so to obtain accurate data.

As for dep. claim 45 (part of 44), note that the phrase "strategy capable of being implemented by" carries no patentable weight in a method claim since this merely refers to "capability" or "potential" of the recommendation and no further step has been carried out. The recommendation of www.Bizrate.com /REBANE inherently includes that capability or strategy (see page "Consulting Services", note (C), items 1-4).

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As for dep. claim 47 (part of 44), which has similar limitation as in dep. claim 40 (part of 39) above, it's rejected for the same reason set forth in dep. claim 40 above.

4. Dependent claims 6, 8, 10-11 (part of 1), 20, 23, 24, 22 (part of 17) are rejected under 35 U.S.C. 103(a) as being unpatentable over www.Bizrate.com /REBANE or vice versa as applied to claims 1-3, 5, 7, 9 and 17-18 21, 26-30 above, and further in view of D'ALESSANDRO.

As for dep. claims 6, 8, 10-11, 20, 22-24, the teachings of www.Bizrate.com /REBANE is cited above. D'ALESSANDRO fairly discloses a method for providing information to an organization having at least one manager, comprising:

(a) an automated evaluation processor receives evaluation data from a survey from at least one service evaluator (consumer or customer or client) {see col. 2, lines 60-67 (or c2:60-67), c5:5-10, c8:55 to c9:5};

(b) the at least one service evaluator directly contacting the evaluation processor for providing evaluation data, the data containing a unique identification (ID) of the organization {c5:45-60, c6:35-45};

(c) the evaluation processor analyzed and evaluated the survey data to evaluate the performance of the organization using a selected formula or business performance model (correlation) to produce a final compiled file (result), wherein the organization staff or manager can access the file from the evaluation process {see c3:25-40, c5:60-67, c6:1-5}. Note, on c3:35-45, D'ALESSANDRO discloses the advantages of carrying out the survey using the Internet such as fast, convenience, accessibility, availability

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and wide area application at the same time. Note, also on c10:8-20, D'ALESSANDRO also mentions immaterial modifications, such as selection of various parameters mentioned in col. 5 and col. 8-9 or other adjustments, are within the scope of the invention and/or would have been obvious to a skilled artisan. Note that even though D'ALESSANDRO talks about evaluates current business performance of an organization, i.e. between the **employees** and the **employer/manager**, on c5:5-20, D'ALESSANDRO mentions another embodiment of the invention, deals with an external pool of respondents, which include consumers, customers or clients of the business entity and the survey can cover areas such as customer satisfaction of the company's performance for providing service or a product {see c8:55-60, c9:1-5}.

Therefore, it would have been obvious to modify the teachings of www.Bizrate.com /REBANE to include other business evaluation process such as within an organization and between employees and the employer/manager as taught by D'ALESSANDRO as mere application the same surveying steps (concepts) to other similar business structures to achieve similar results.

5. Claims 44-47 (method⁵), are rejected under 35 U.S.C. 103(a) as being unpatentable over www.Bizrate.com (* Feb 29, 2000) in view of REBANE (US Patent 6,539,392) or vice versa and further in view of SUZUKI (US Patent 6,129,274).

In a method for updating transaction data, SUZUKI teaches the step of matching appropriate transactional data to the customer data for proper data uploading during a batch process or at some later time {see col. 11, line 60 to col. 12, line 7}. It would have

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been obvious to modify the process of www.Bizrate.com /REBANE or vice versa to further include the step of matching the transactional data to the personal data as taught by SUZUKI for proper data uploading during a batch process or at some time later.

As for dep. claim 45-47, they are rejected for the same reason set forth above.

Response to Arguments

6. Applicant's arguments with respect to claims 1-3, 5-18, 20-38 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Article "Robertson Stephens... Com" discloses Bizrate.com collect information directly from consumer feedback and transaction information.

No claims are allowed.

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9. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through private PAIR only. For more information about the PAIR system, see <http://pair-direct@uspto.gov>. Should you have any questions on access to the private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

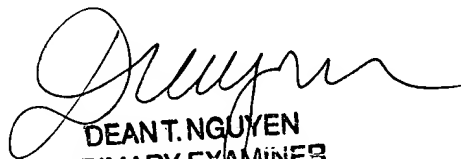
In receiving an Office Action, it becomes apparent that certain documents are missing, e. g. copies of references, Forms PTO 1449, PTO-892, etc., requests for copies should be directed to Tech Center 3600 Customer Service at (571) 272-3600, or e-mail CustomerService3600@uspto.gov.

Any inquiry concerning the merits of the examination of the application should be directed to Dean Tan Nguyen at telephone number (571) 272-6806. My work schedule is normally Monday through Friday from 6:30 am - 4:00 pm. I am scheduled to be off every other Friday.

Should I be unavailable during my normal working hours, my supervisor John Weiss can be reached at (571) 272-6812.

The main FAX phone numbers for formal communications concerning this application are (571) 273-8300. My personal Fax is (571) 273-6806. Informal communications may be made, following a telephone call to the examiner, by an informal FAX number to be given.

dtn
October 26, 2005


DEAN T. NGUYEN
PRIMARY EXAMINER